REMARKS

Status of the claims

Claims 22-24 and 28-39 are pending and under consideration in this application. All the claims under consideration stand rejected. Claims 24 and 34-39 are cancelled. Claim 33 has been amended to correct its dependency i.e., it has been made dependent on 32, which contains the appropriate antecedent term "carrier". After entry of the amendments made herein, claims 22, 23, and 28-33 will be pending and under consideration in this application.

35 U.S.C. § 112, first paragraph, rejections

For the record, Applicants draw the Examiner's attention to the fact that:

(i) with respect to the comment on page 3, line 5, of the Office Action, claim 22 was amended and claims 23-33 were newly presented in the Amendment and Response filed August 17, 2004, and not in Amendment and Response immediately previous to the present one, i.e., that of March 15, 2005; and

(ii) with respect to the comments on page 3, lines 9-10, and page 7, lines 3-4, of the Office Action, claim 23 was amended as indicated in the cited text of the Office Action in the Amendment and Response filed August 17, 2004, and not in Amendment and Response immediately previous to the present one, i.e., that of March 15, 2005.

Moreover, with respect to the comments on page 3, lines 15-18, and page 7, lines 9-12, Applicants agree with the Examiner that structures disclosed in the '834 patent are incorporated by reference into the present specification. However, Applicants do not agree with the statement that the present specification "imports recitations directed to Rho-family member-mediated inhibition of neuronal axon growth and Rho family antagonist that antagonizes Rho-associated kinase activity." (underlining added). Clarification is requested.

(a) Claims 22-24 and 28-29 stand rejected as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventors, at the time the application was filed, had possession of the claimed invention.

From the comments on page 3, line 1, to page 6, line 8, of the Office Action, Applicants understand the Examiner's position to be that claims 22-24 and 28-39 enjoy support from the specification as previously submitted in the Amendment and Response filed August 17, 2004, but that the citations noted therein do not support the recitations and combinations of elements as newly recited.

The Examiner acknowledges that, while paragraph 21 refers to the '834 patent, the paragraph supports the recitation where "compounds such as Y-27632 (US 4,997,834) that block Rho-associated kinase activity, ... are embodiments of this invention and "the use of other compounds within this family of compounds that inhibit Rho kinase are also considered within the scope of this invention."

Applicants further understand the Examiner's position to be that while the specification notes such activities with Y-27632, no other compounds or scope of compounds appear to be noted as providing for the noted functional recitations. While not agreeing with this position, to expedite prosecution of the application, Applicants have amended claim 23, without prejudice to its embodiments prior to amendment being presented in a separate application, to incorporate the limitation of claim 24, i.e., the Y-27632 compound, and have cancelled claim 24 as well as claims dependent on claim 24 (claims 34-39).

In addition, Applicants understand the Examiner's position to be that the specification does not apparently support the combination for the selection of antagonists to be used via the noted functional activities of stimulating regenerative nerve growth of damaged neuronal axons past the lesion site and wherein the antagonist has the ability, when triturated into primary retinal ganglion cells in vitro to produce outgrowth of retinal ganglion cell neurites, the retinal ganglion cells being plated on a growth inhibitory substrate selected from the group consisting of myelin and chondroitin sulfate proteoglycan as now claimed. The Examiner alleges that there is no evidence that any other compounds possess such functional activities. Applicants note that these

functional limitations were deleted from claim 23 in the Amendment and Response filed March 15, 2005. Furthermore, as noted above, claim 23 now specifies only the Y-27632 compound.

The Examiner also notes that Applicants' arguments in the Amendment and Response filed March 15, 2005, were fully considered and concluded to be persuasive in part, to the extent of Y27632, but not to extend to compounds that are pharmaceutically acceptable addition salts thereof or to compounds with the formula of claim 23, other than Y27632. While not agreeing with this conclusion, Applicants, without prejudice to their being presented in a separate application, have amended claims 22 and 23 to delete pharmaceutically acceptable addition salt embodiments.

Applicants respectfully submit that, in view of the amendments to claims 22 and 23, the above-described objections to the claims are moot.

(b) Claims 22-24 and 28-39 stand rejected on the grounds that the specification allegedly does not enable any person skilled in the art to which pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

From the comments on page 6, line 9, to page 10, line 8, of the Office Action, Applicants understand the Examiner's position to be that claims 22-24 and 28-39 are rejected because the specification, while being enabling for Y-27632, does not reasonably provide enablement for the full scope of the other compounds encompassed as directed to pharmaceutically acceptable addition salts thereof and compounds within the structural formula of claim 23 that exhibit the ability to suppress Rho family member-mediated inhibition of neuronal axon growth and antagonizes Rho-associated kinase activity.

Applicants also understand the Examiner's position to be that while the specification notes such activities with Y-27632, no other compounds or scope of compounds appear to be noted as providing for the noted functional recitation.

Moreover, Applicants understand the Examiner's position to be that the specification does not support the combination for the selection of antagonists to be used via the noted functional activities of stimulating regenerative nerve growth of damaged neuronal axons past

the lesion site and wherein the antagonist has the ability, when triturated into primary retinal ganglion cells in vitro to produce outgrowth of retinal ganglion cell neurites, the retinal ganglion cells being plated on a growth inhibitory substrate selected from the group consisting of myelin and chondroitin sulfate proteoglycan as now claimed. The Examiner alleges that there is no evidence that any other compounds possess such functional activities. Applicants note that these functional limitations were deleted from claim 23 in the Amendment and Response filed March 15, 2005.

Furthermore, Applicants also understand the Examiner's position to be that enablement with respect to Y-27632 does not extend to compounds that are pharmaceutically acceptable salts thereof or to compounds within the formula of claim 23, other than Y-27632. The Examiner's position is apparently that the evidence does not correlate with the full scope of the claims sufficient to show that the structural and functional constraints recited are correlated to suppression of Rho family member-mediated inhibition and antagonism of Rho-associated kinase activity or of "rho-inase".

In addition, Applicants understand the Examiner's position to be that the claims encompass a large genus of compounds comprising "pharmaceutically acceptable addition salts thereof" and a multitude of compounds falling within the scope of the recited generic formula, none of which are evidenced to exhibit the functional activities of either antagonizing Rho-associated kinase activity or for suppression of Rho family member-mediated inhibition of neuronal axon growth other than the single compound Y-27632. Applicants also understand the Examiner's position to be that the single species member, here Y-27632, does not adequately support the genus or evidence that applicants were in possession of the full genus, and that there is no supportive evidence of a correlation between the noted structurally related compounds and the recited biological functions, nor is there any evidence that any other member, other than Y-27632, with the recited structure would be sufficient to provide for the instantly claimed activities.

While not agreeing with above positions, and Applicants respectfully submit that the above-described objections to the claims are rendered moot by the amendments to the claims (see above).

In light of the above considerations, Applicants respectfully request that the rejections under 35 U.S.C. 112, first paragraph, be withdrawn.

CONCLUSION

In summary, for the reasons set forth above, Applicants maintain that the pending claims patentably define the invention. Applicants request that the Examiner reconsider the rejections as set forth in the Office Action, and permit the pending claims to pass to allowance.

If the Examiner would like to discuss any of the issues raised in the Office Action, Applicants' undersigned representative can be reached at the telephone number listed below.

Please charge any fees or make any credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 12552-003001.

Respectfully submitted,

Date: 10/26/05

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